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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,066	07/31/2003	John Paul Dodson	AUS920030532US1	3527
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IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			EXAMINER REVAK, CHRISTOPHER A	
			ART UNIT 2131	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/631,066	<b>Applicant(s)</b> DODSON ET AL.	
	<b>Examiner</b> Christopher A. Revak	<b>Art Unit</b> 2131	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 April 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-9,11-15 and 17-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,11-15 and 17-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/31/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed have been fully considered but they are not persuasive. The applicant's amendments to the claims fail to overcome the rejection under 35 USC 101 as being directed towards non-statutory subject matter.

With regards to claims 15-20, the Interim Guidelines for Examiner of Patent Applications for the Patent Subject Matter Eligibility published in the Official Gazette on November 22, 2005, Section Annex IV (c), indicated "signal claims are ineligible for patent prosecution because they do not fall within any of the four statutory classes of Section 101". In the instant application, the examiner refers to the applicant's specification, beginning on page 17, line 33 through page 18, line 5, various examples of media is given, however transmission media is recited as a particular type of media that is non-statutory.

As per claim 21, it is unclear how a computer program product in a data processing system makes the claim statutory as argued by the applicant, whereby the rejection is maintained by the examiner. The claim recites of a computer program product which is not stored on a computer readable storage/recording medium and the claims are software alone, and of itself.

2. Applicant's amendments overcome the rejection under 35 USC 112 2<sup>nd</sup> paragraph, the rejection has been withdrawn by the examiner.

3. The applicant's arguments filed have been fully considered but they are not persuasive. It is argued by the applicant that the teachings of Jin et al fail to disclose of a "privileged address" being provided to a client responsive to authentication information being authenticated. It is additionally argued that "any type of privileged address" is not taught by Jin et al and that the prior art teachings of Jin et al disclose of a "genuine address" which is not the same as a "privileged address" and is not identically shown as a single reference.

As per independent claims 1,8,15, and 22, the examiner disagrees with the applicant's assertion. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., defining what constitutes a privileged address) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The examiner agrees that the teachings of Jin et al do not disclose of the term "privileged address", but rather claims a "genuine IP address" being provided to client. It appears that the applicant is interpreting the term "privileged address" in light of the applicant's specification, however the examiner is broadly interpreting the limitation of a "privileged address" as being any type of address being provided to an authenticated entity.

The teachings of Jin et al disclose of an access reply packet, or authentication information" that contains username and password information, the access reply packet is then authenticated and upon successful authentication, an IP address is assigned in the access reply packet, see column 4, lines 53-54 and column 4, line 62 through column 5, line 10. The IP address assigned is a genuine IP address, or privileged address, see column 5, lines 22-24.

4. Applicant's arguments with respect to claims 7,14, and 21 have been considered but are moot in view of the new ground of rejection.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 15-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 15-20 recite of a computer readable medium that is directed toward non-statutory subject. According to the applicant's specification, beginning on page 17, line 33 through page 18, line 5, various examples of media is given, however transmission media is recited as a particular type of media that is non-statutory. The examiner notes that the applicant's specification is written in a manner which separates recordable media versus transmission media and the examiner suggests amending claim 15 to recite that the computer readable medium is either "recording medium" or a "storage medium".

As per claim 21, the claim recites of a computer program product which is not stored on a computer readable storage/recording medium. The claims are software alone, and of itself and should be amended to indicate that the computer program product is stored on "computer readable storage/recording medium."

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1,3,4,5,11,12,15, and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Jin et al, U.S. Patent 6,311,275.

As per claim 1, Jin et al teaches of a method in a data processing system for providing addresses to clients, the method comprising receiving a request from a client for an address; determining whether authentication information is present in the request; performing an authentication process using the authentication information if the authentication information is presenting the request; determining whether the authentication information is authenticated; and responsive to the authentication information being authenticated, providing a privileged address to the client and responsive to the authentication information not being authenticated, providing a dummy (standard) address to the client (col. 4, line 44 through col. 5, line 10 and col. 5, lines 11-24).

As per claim 3, it is taught by Jin et al wherein the address is an Internet Protocol address (col. 5, lines 1-3).

As per claim 4, it is disclosed by Jin et al wherein the authentication information is a pass phrase (col. 4, lines 53-54).

As per claim 5, Jin et al teaches wherein the authentication process determines whether the pass phrase is a valid pass phrase (col. 4, lines 53-54).

As per claim 11, it is taught by Jin et al wherein the authentication information is a pass phrase (col. 4, lines 53-54).

As per claim 12, it is disclosed by Jin et al wherein the authentication process determines whether the pass phrase is a valid pass phrase (col. 4, lines 53-54).

As per claim 15, it is taught by Jin et al of a computer program product in a computer readable medium for providing addresses to clients, the computer program product comprising first instructions for receiving a request from a client for an address; second instructions for determining whether authentication information is present in the request; third instructions for performing an authentication process using the authentication information if the authentication information is presenting the request; fourth instructions for determining whether the authentication information is authenticated; and fifth instructions, responsive to the authentication information being authenticated, for providing a privileged address to the client and responsive to the authentication information not being authenticated, providing a dummy (standard) address to the client (col. 4, line 44 through col. 5, line 10 and col. 5, lines 11-24).

As per claim 17, Jin et al teaches wherein the address is an Internet Protocol address (col. 5, lines 1-3).

As per claim 18, Jin et al discloses wherein the authentication information is a pass phrase (col. 4, lines 53-54).

As per claim 19, it is taught by Jin et al wherein the authentication process determines whether the pass phrase is a valid pass phrase (col. 4, lines 53-54).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 6,13, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jin et al, U.S. Patent 6,311,275.

The teachings of Jin et al disclose of using password information in order to validate a user prior to assignment of a privileged address, however the teachings of Jin et al fail to disclose of using and validation of a digital certificate and which includes information indicating whether the certificate is from a trusted authority. The examiner hereby takes official notice that using and validation of a digital certificate and which includes information indicating whether the certificate is from a trusted authority is notoriously well known to one of ordinary skill in the art. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have been motivated to



apply the use of digital certificates as an alternative source of validation. It is notoriously well known that digital certificates are issued from trusted third parties wherein they can be validated and contain unique information as to who issued the certificate, the user it is assigned to, the user's public key, and validation periods that the certificate is valid for a certain length of time. It is obvious that the teachings of Jin et al could have been altered in order to include the use of digital certificates wherein the digital certificates would contain additional unique information that would more appropriately validate the user and issuer of the certificate.

11. Claims 7,14, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Droms, RFC 2131 in view of Droms et al, RFC 3118.

As per claims 7,14, and 21, it is taught by Droms, RFC 2131 of a receiving a request from a client for an address; determining whether information is present in the request; performing a verification process using the information if the information is present in the request; determining whether the information is verified; responsive to the information being verified, providing an address to the client; responsive to the information not being verified, denying the request receiving the address by the client, wherein the address received by the client is included in an offer from a server that performed the verification process; determining, by the client, whether the offer is valid; and responsive to the offer being valid, accepting the offer by the client (section 3.1, page 13 and steps 3-5 on pages 15-16). The teachings of Droms, RFC 2131 fail to disclose of using authentication information to be authenticate the DHCP

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communications between the server and the client. In an expanded teaching of Droms, RFC 2131, Droms et al, RFC 3118 discloses that authentication occurs between a server and client in order to complete the DHCP process (page 4, section 1.4, step 5; page 6, section 5.3; and page 7, section 5.5.1). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have been motivated to use authentication measures in order to validate the assignment of an IP address. The teachings of Droms et al, RFC 3118 recite of motivation for use of authentication by disclosing that the allocation of addresses is limited to authorized hosts and of the need for authenticating the source and content of DHCP messages (abstract) and it is obvious that the teachings of Droms, RFC 2131 would have been made more secure by use of authentication of the host and server as disclosed by Droms et al, RFC 3118.

12. Claims 8,9, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jin et al, U.S. Patent 6,311,275 in view of Bahl et al, U.S. Patent 6,957,276.

As per claim 8, it is disclosed by Jin et al of a data processing system for providing addresses to clients, the data processing system comprising receiving means for receiving a request from a client for an address; first determining means for determining whether authentication information is present in the request; performing means for performing an authentication process using the authentication information if the authentication information is present in the request; second determining means for determining whether the authentication information is authenticated; and providing means, responsive to the authentication information being authenticated, for providing a

privileged address to the client (col. 4, line 44 through col. 5, line 10 and col. 5, lines 22-24). The teachings of Jin et al fail to disclose that the privileged address is a static IP address that is identical to a previous address that was provided to a client. It is taught by Bahl et al that the privileged address is a static IP address that is identical to a previous address that was provided to a client (col. 2, lines 57 through col. 3, line 7). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have been motivated to reclaim static addresses. The teachings of Bahl et al discloses of motivation for static IP address being is identical to a previous address that was provided to a client by reciting of an automated approach so that the assignment of static addresses can be done in a centralized manner so that an administrator doesn't have to physically visit each machine to make the changes (col. 2, lines 12-17 & 57-63). It is obvious that the teachings of Jin et al would have found the teachings of Bahl et al beneficial so that the same static addresses can be assigned in a centralized manner.

As per claim 9, Jin et al teaches of further comprising providing means, responsive to the authentication information not being authenticated, for providing a standard address to the client (col. 5, lines 11-21).

As per claim 22, Jin et al discloses of a data processing system for providing addresses to clients, the data processing system comprising a bus system; a memory connected to the bus system, wherein the memory includes a set of instructions; a communications adaptor connected to the bus system; and a processor unit connected to the bus system, wherein the processor unit-executes the set of instructions to receive

a request from a client for an address; determine whether authentication information is present in the request; perform an authentication process using the authentication information if the authentication information is presenting the request; determine whether the authentication information is authenticated; and provide a privileged address to the client in response to the authentication information being authenticated (col. 4, line 44 through col. 5, line 10 and col. 5, lines 22-24).

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Revak whose telephone number is 571-272-3794. The examiner can normally be reached on Monday-Friday, 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CR  
  
June 21, 2007

CHRISTOPHER REVAK  
PRIMARY EXAMINER

